UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

az

Mailed: June 21, 2002

Concurrent Use No. 1,169

Nutrition Care Systems, Inc.

v.

NCS HealthCare, Inc.

Before Wendel, Bucher and Rogers, Administrative Trademark Judges.

By the Board.

Nutrition Care Systems, Inc. (hereinafter "applicant") has filed an application for a concurrent use registration for the mark NCS for "dietary consulting services namely, nutrition management services, food management consulting, and menu services for health care facilities."[1] The application, which seeks registration for the geographic area consisting of the states of Illinois, Wisconsin, Iowa and Missouri, sets forth NCS HealthCare, Inc. as the exception to applicant's claim of

an otherwise exclusive right to use its mark in commerce. NCS HealthCare, Inc. had earlier filed applications for the mark NCS (in typed form)[2] and for the mark:[3]

Both applications recite the following services:

> health care services, namely, pharmacy consulting in the field of health care plans; nutritional services, namely, operating diet kitchens for nursing facilities and health care facilities; rehabilitation services; infusion therapy services; medical home care services; pharmacy psychiatric consulting services; consulting services directed to medicare part B patient and health care services; environmental consulting services; and consulting in the field of building and physical plant security measures.

NCS HealthCare, Inc.'s NCS mark has registered as territorially unrestricted Registration No. 2,229,820 and the NCS HEALTHCARE (stylized) mark has registered as territorially unrestricted Registration No. 2,229,819.[4]

---

[1] Application Serial No. 75/433,055 was filed on February 12, 1998 and claims first use of the mark on December 17, 1993 and first use in commerce on February 6, 1995.
[2] Application Serial No. 75/032,801 was filed on December 14, 1995 and claims first use of the mark and first use in commerce in April, 1974.
[3] Application Serial No. 75/032,800 was filed on December 14, 1995 and claims first use of the mark and first use in commerce in January, 1978; HEALTHCARE has been disclaimed.
[4] Both marks registered on March 9, 1999.

This case now comes up on NCS HealthCare, Inc.'s (hereinafter "registrant") motion for summary judgment. According to registrant:

> Nutrition Care will be unable, as a matter of law, to meet its 'burden of proof' that there will not be a likelihood of confusion if Nutrition Care's concurrent use application is permitted to register. Both NCS HealthCare and Nutrition Care are using and/or advertising identical service marks (viz. "NCS") for services to nursing homes or centers in the territorial area claimed by concurrent use applicant. Moreover, by its repeated cease and desist correspondence to NCS, Nutrition Care has previously taken the position so firmly as to amount to an admission that a likelihood of confusion will exist in the market place.

In support of its motion, registrant has filed the affidavit of Wayne Morrow, registrant's Director of Marketing, who states as follows:

1. NCS HealthCare has been providing dietary consulting and management services under the mark "NCS" since approximately 1974.

2. NCS HealthCare has been promoting NCS services, including, dietary consulting and management services via the Internet[,] since at least as early as 1996.

3. NCS HealthCare provides dietary consulting and management services in, inter alia, Illinois, Wisconsin, Iowa and Missouri.

4. NCS HealthCare advertises dietary consulting and management services in, inter alia, Illinois, Wisconsin, Iowa and Missouri.

Registrant has also filed a printout of one of its Web pages; three "cease and desist" letters in which

applicant contends that registrant’s NCS HEALTHCARE mark infringes applicant's NCS mark; and copies of the

registrations for registrant's NCS and NCS HEALTHCARE marks.[5]

In its filings of January 24, 2002 and March 4, 2002, applicant raises arguments regarding the chain of title for the NCS and NCS HEALTHCARE registrations. This concurrent use proceeding, however, only concerns the question of whether applicant is entitled to a concurrent use registration in the recited territories and with the excepted user *named by applicant* in its concurrent use application. Applicant's arguments do not concern this question.

Summary judgment, which registrant seeks, is an appropriate method of disposing of a case in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The purpose of summary judgment is to avoid an

[5] We have not received a supporting affidavit or declaration in connection with registrant's evidence. See Fed. R. Civ. P. 56(e). Because applicant has not objected to registrant's evidence on this basis, we have considered registrant's evidence as if it had been stipulated into the record.

For the benefit of the parties regarding evidence taken from the Internet, however, we advise that printouts from the Internet are not self-authenticating. In order for a printout from a Web page to be made of record in connection with a motion for summary judgment, it should be introduced through a declaration or affidavit of the person who accessed the Web page. See Trademark Rule 2.122(e); Fed. R. Civ. P. 56(e); and

unnecessary trial where additional evidence would not reasonably be

Fed. R. Evid. 901(a). See also *Raccioppi v. Apogee,* 47 USPQ2d 1368 (TTAB 1998).

expected to change the outcome. See *Pure Gold, Inc. v. Syntex (U.S.A.), Inc*., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). The evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Old Tyme Food, Inc. v. Roundy's Inc.,* 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Our starting point in addressing registrant's motion is with Section 2(d) of the Trademark Act,[6] which concerns,

---

[6] Section 2(d) provides:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it --

* * *

(d) consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, that when the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods in connection with which such marks are used, concurrent registrations may be issued to such

inter alia, circumstances under which concurrent use registrations may issue. The concurrent use proviso of Section 2(d) sets out two requirements for issuance of a concurrent use registration of the same or similar mark to more than one person. First, an applicant must have become entitled to use the mark as a result of lawful concurrent use in commerce prior to the dates recited in the proviso (in this case, applicant must have use prior to the earliest of the filing dates of the applications which matured into registrant's registrations); and second, it must be determined that confusion is not likely to result from the continued use of applicant's mark in the territory claimed. See *In re Beatrice Foods Co.*, 429 F. 2d 466, 166 USPQ 431 (CCPA 1970); and *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879 (TTAB 1985).

With respect to the first or the jurisdictional requirement for concurrent use registrations, there is no dispute that applicant's use of NCS for the recited services commenced prior to the filing date of the applications which matured into the NCS and NCS

---

persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (i) the earliest of the filing dates of the applications pending or of any registration issued under this Act … .

HEALTHCARE registrations. We have no reason to assume that this was other than an innocent use without notice of registrant's use and activity under the NCS and NCS HEALTHCARE marks. Thus, the jurisdictional requirement of "lawful use in commerce" prior to the earliest filing dates of the registrations of registrant involved in this proceeding is satisfied, and the only issue is whether confusion would be likely from the continued use of applicant's mark in the territory claimed.

In regard, however, to the second requirement of the Section 2(d) concurrent use proviso, we believe that confusion under Section 2(d) is likely to result from applicant's use of its mark in the recited territory. Our determination is based on an analysis of the facts in evidence that are relevant to the factors identified in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) as bearing on the likelihood of confusion issue. Two key considerations which we focus on are the similarities or dissimilarities of the marks and the similarities or dissimilarities between the identified goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Insofar as the marks are concerned, applicant and registrant’s NCS marks (both in typed form) are identical, and applicant's NCS mark and registrant’s NCS HEALTHCARE mark, (with HEALTHCARE disclaimed and NCS as the dominant portion of the mark),[7] are highly similar. In this regard, we also rely on applicant's own letters to registrant

[7] NCS is the dominant portion of the NCS HEALTHCARE mark because HEALTHCARE identifies applicant's “healthcare” services, it has been disclaimed, and it appears in smaller letters in a different font than the term NCS, which has a thick bold font.

alleging that use of registrant’s marks infringes on applicant's mark. Thus, we conclude that there is no genuine issue of material fact as to the similarities of the marks.

Turning next to the services, we limit our analysis of the similarity or relatedness of the services to the identifications in the involved application and registrations. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990), and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In our view, there is no genuine issue of material fact that applicant's “dietary consulting services namely, nutrition management services, food management consulting, and menu services for health care facilities” are highly similar to registrant’s “nutritional services, namely, operating diet kitchens for nursing facilities and health care facilities.” Both are nutritional services offered to health care facilities and applicant has as much as admitted that the services are the same in its November 2, 1996 “cease and desist” letter, stating that registrant offers “the same dietary consulting and management services as” applicant. Also, applicant, in

its response to the motion for summary judgment, has not disputed registrant's contention that both parties' services are directed to nursing homes or centers.

Thus, we conclude that there is no genuine issue of material fact that purchasers or prospective purchasers of the parties' dietary consulting or nutritional services, are likely to believe that the services are somehow affiliated with or sponsored by the same entity.

Whether such purchasers will encounter both parties' marks in circumstances wherein confusion will be likely is the salient question raised by registrant's summary judgment motion.[8] Registrant maintains that "both concurrent use applicant and registrant are providing dietary consulting and management services in Illinois, Wisconsin, Iowa and Missouri under the service mark 'NCS,'" and Mr. Morrow has testified in paragraphs 3 and 4 of his affidavit that registrant provides and advertises dietary consulting and management services in

[8] It is well established that where the trading territories of concurrent users overlap in actual use, that fact precludes the granting of concurrent use registrations, see *Daniel R. Gray, d.b.a. Daffy Dan's v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987); *My Aching Back, Inc. v. Alfred Klugman*, 6 USPQ2d 1892 (TTAB 1988); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, *supra*; *In re Place for Vision, Inc.*, 196 USPQ 267 (TTAB 1977); *Texas Meat Packers, Inc. v. Rueckert Meat Co.*, 143 USPQ 325 (TTAB 1964); and *Central West Oil Corp. v. Continental Oil Co.*, 135 USPQ 469 (TTAB 1962).

the states claimed by applicant in its application. In view thereof, we conclude that there is no genuine issue of material fact that registrant is using its mark in the territories claimed by applicant in its concurrent use application.

Because we have concluded that there is a likelihood of confusion from the concurrent use of applicant's mark and registrant’s mark, for the identified services, and that registrant is using its marks in the territories claimed by applicant, applicant cannot satisfy the second of the two Section 2(d) requirements for the issuance of a concurrent use registration, i.e., that confusion is not likely to result from the continued use of applicant's mark in the territory claimed. We therefore grant registrant’s motion for summary judgment, dissolve the concurrent use proceeding; and refuse registration of applicant's concurrent use application.